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Attorney's Docket No.: C110470073

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frederick M. Morgan, et al.
Serial No: 09/675,419
Confirmation No.: 9659
Filed: September 29, 2000
For: SYSTEMS AND METHODS FOR CALIBRATING LIGHT OUTPUT BY
LIGHT-EMITTING DIODES

Examiner: Kao, Chih-Cheng Glen
Art Unit: 2882

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 7th day of July, 2003.

Lori A. Biancuzzo
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following documents:

Response to Restriction Requirement/Election
 Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch are respectfully requested to contact the undersigned at (617) 395-7000.

A check is not enclosed. If a fee is required, the Commissioner is hereby authorized to charge Deposit Account No. 50/2762. A duplicate of this sheet is enclosed.

Respectfully submitted,
Frederick M. Morgan, et al., Applicants

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*J4/Electronics
J. Merkey
7-19-03*

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RESPONSE TO RESTRICTION REQUIREMENT/ELECTION

Sir/Madam:

In response to the Office Action mailed June 4, 2003 in the above-identified application, Applicants hereby elect the invention of Group I, namely, claims 1-29, 38-55, 57-63, 65, and 87-101 for further prosecution.

This election is made with traverse, as the Applicants respectfully submit that search and examination of all of the claims pending in the present application can be made without serious burden on the Examiner. In particular, as discussed during a telephone conference between Examiner Kao and Applicant's representative in early June 2003, the independent claims that are the subject of the present Restriction Requirement already have been examined by the Examiner in two previous Office Actions (Office Action mailed October 22, 2002 and Office Action mailed February 22, 2002).

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More specifically, in the current Restriction Requirement, independent claims 1, 7, 16, and 25 fall within the first group identified by the Examiner, whereas only independent claim 30 falls within the second group identified by the Examiner. Each of these independent claims has been pending since the filing of this application, and has been examined by the Examiner in two Office Actions to date. While some minor amendments to these claims have been made during prosecution, the subject matter covered by the claims essentially has not changed. Hence, by the Examiner's own prior actions, the Examiner has conceded that search and Examination of these claims can be made without a serious burden (see MPEP §803).

In support of the present Restriction Requirement, the Office Action states that the inventions corresponding to the claims of the indicated groups I and II allegedly are related as process and apparatus for its practice. According to MPEP §806.05(e), a process and an apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process. The MPEP points out that the burden is on the Examiner to provide reasonable examples that recite material differences. MPEP §806.05(e) also states that if the apparatus claims include a claim to include "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention. If this claim ultimately is allowed, rejoinder is required (see MPEP §809.04).

First, Applicants respectfully submit that the Office Action has not provided a reasonably explained example that recites material differences between the process and apparatus. The Office Action merely states that "the process as claimed can be practiced by another materially different apparatus such as a fiber optic communications system with a voltage output measurement." Inasmuch as Applicants can understand this comment, Applicants respectfully point out that the present invention has absolutely nothing to do with fiber optic communications systems, and as such the role of fiber optic communication systems as an apparatus to practice the process claimed in the group II claims, as alleged in the Office Action, is unclear.

Second, Applicants respectfully point out that at least claim 87 and the claims depending therefrom, which are apparatus claims of Group I, include a claim to "means" for practicing the process recited in the Group II claims (i.e., independent claim 30 and the claims depending therefrom). Accordingly, at very least, claim 87 should be identified as a linking claim and, if

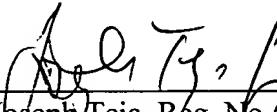
ultimately allowed, rejoinder of the non-elected Group II claims is required pursuant to MPEP §809.04.

In sum, Applicants have distinctly and specifically pointed out what are respectfully believed to be errors in this Restriction Requirement, and hence traverse this requirement. In doing so, Applicants retain the right to petition from the requirement under 37 C.F.R. §1.144.

Applicants respectfully request the Examiner to reconsider and withdraw the Restriction Requirement and proceed with prosecution on the merits of all of the presently pending claims.

Respectfully submitted,

Frederick M. Morgan, et al., Applicants

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